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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,358	10/11/2001	Christopher L. Chua	D/99842QD	3565

7590            07/27/2004

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EXAMINER

NGUYEN, DAO H

ART UNIT

PAPER NUMBER

2818

DATE MAILED: 07/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/975,358	CHUA ET AL. <i>An</i>	
	<b>Examiner</b>	<b>Art Unit</b>	
	Dao H Nguyen	2818	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

#### A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 28 June 2004.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1 and 12-17 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) 12-15 is/are allowed.  
 6) Claim(s) 1,16 and 17 is/are rejected.  
 7) Claim(s) 17 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 11 October 2001 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1001</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. In response to the communications dated 10/11/2001 through 06/28/2004, claims 1 and 12-17 are active in this application as a result of the cancellation of claims 2-11 in the Preliminary Amendment.

### **Acknowledges**

2. Receipt is acknowledged of the following items from the Applicant.

a. Information Disclosure Statement (IDS) filed on 10/11/2001 and made of record as Paper No. 1001. The references cited on the PTOL 1449 form have been considered.

Applicant is requested to cite any relevant prior art if being aware on form PTO-1449 in accordance with the guidelines set for in M.P.E.P. 609.

b. This patent application is a divisional patent application of U.S. Patent Application Number 09/573,363 filed on May 17, 2000, now patent No. 6,396,677.

### **Specification**

3. The specification is objected to for the following reason:

In the abstract, lines 8-9, the preposition "a" in the phrase "the a dielectric layer" should be deleted.

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### **Claim Objections**

4. The claim is objected to for the following reason: In claim 17, line 26, the period “.” at the end of the line should be replaced by a semicolon --;--.

### **Claim Rejections - 35 USC § 112**

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim(s) 16-17 is/are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 16, it is not clearly defined and distinctly pointed out the subject matter which is claimed as the Applicant's invention. What is the preamble and what is the body of the claim? It is an incomplete claim.

Regarding claim 17, it is not clearly defined and distinctly pointed out the subject matter which is claimed as the Applicant's invention. It is a method of doing what? This claim has no preamble.

### **Claim Rejection - Double Patenting**

7. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

8. Claim 1 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of prior U.S. Patent No. 6,396,677. This is a double patenting rejection.

### **Reasons for Allowance**

9. Claim(s) 12-15 would be allowed.

The following is an examiner's statement of reason for allowance:

None of the references of record teaches or suggests the claimed method for forming a variable capacitor comprising (in addition to the other limitations in the claim) under-cut etching a portion of the insulating release layer under the second conductive layer to release a free portion of the second layer from the release layer, wherein an anchor portion of the second layer remains fixed to the release layer.

### **Allowable Subject Matter**

10. Claim(s) 17 would be allowed if rewritten to overcome the rejection under 35 USC § 112.

The following is a statement of reason for the indication of allowable subject matter: None of the references of record teaches or suggests the claimed method for forming a variable capacitor comprising (in addition to the other limitations in the claim) under-cut etching a portion of the insulating release layer under the second conductive layer to release a free portion of the capacitor plate layer and the microcoil layer from the release layer, wherein an anchor portion of the second layer remains fixed to the release layer.

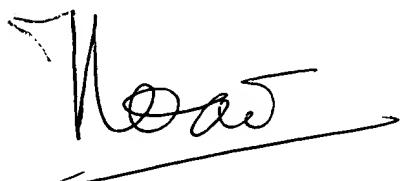
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### Conclusion

11. A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) day from the day of this letter. Failure to respond within the period for response will cause the application to become abandoned (see M.P.E.P 710.02(b)).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dao H. Nguyen whose telephone number is (571)272-1791. The examiner can normally be reached on Monday-Friday, 9:00 AM – 6:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Nelms can be reached on (571)272-1787. The fax numbers for all communication(s) is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-1625.



Dao H. Nguyen  
Art Unit 2818  
July 21, 2004



David Nelms  
Supervisory Patent Examiner  
Technology Center 2800